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Dated: November 25, 2002

Signature:

(Arnold H. Krumholz)

Docket No.: LUZZATTO 3.3-051 CIP
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Margel et al.

Application No.: 09/701,210

Filed: March 27, 2001

For: NUCLEATION AND GROWTH OF
MAGNETIC METAL OXIDE
NANOPARTICLES AND ITS USE

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Group Art Unit: 1617
:
Examiner: S. Sharareh
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:

Commissioner for Patents
Washington, DC 20231

COMMUNICATION

Dear Sir:

The present communication is in response to the Official Action mailed September 24, 2002. A petition for a one-month extension of the term for response to said Official Action to and including November 24, 2002 is transmitted herewith.

Applicants hereby elect Group I, claims 1-32 drawn to methods of preparing nanoparticles coated with magnetic metal oxides.

The Official Action also indicated that applicants must make a further election of a single species. Applicants respectfully traverse such requirement as further set forth below. However, applicants hereby provisionally elect the claims of species I, namely, claims 30-32 and 42-56 for prosecution in the present application in the event that such requirement is not withdrawn.

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It is respectfully submitted that a requirement for election of species is inappropriate because the asserted "species" set forth in the Official Action are not in fact separate mutually exclusive species. As set forth in MPEP 806.04(e) and 806.04(f) "species" are "always the specifically different embodiments" of an invention. "Claims are never species." A requirement for election of species is proper only if "one claim recites limitations which under disclosure are found in the first species but not in the second" whereas a second claim recites "limitations disclosed only for the second species and not the first."

Here, the features used to define the species are all in a single embodiment, namely, a method for preparing nanoparticles which enables the utilization of a variety of substrate materials on which the magnetic coating may be formed. Claim 25 recites a particular case of the method of claim 24 and it is illogical to consider it a separate species. Likewise, claims 27-29 are particular cases of the method of claims 25 and 26 and it is illogical to consider them a separate species. Accordingly, reconsideration and withdrawal of the requirement for election of species are respectfully requested.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: November 25, 2002

Respectfully submitted,

By 

Arnold H. Krumholz

Registration No.: 25,428

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorneys for Applicants